THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 69

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PEREZ-SOLER, INSOOK HAN
and ABDUL R. KHOKHAR
Junior Party[1]

v.

ABDUL R. KHOHAR, GABRIEL LOPEZ-BERESTEIN
and ROMAN PEREZ-SOLER
Junior Party [2]

v.

ABDUL R. KHOKHAR, GABRIEL LOPEZ-BERESTEIN
and ROMAN PEREZ-SOLER
Junior Party [3]

[1]Patent No. 5,384,127, based on Application 07/998,413, filed December 29, 1992, issued January 24, 1995. Accorded the benefit of Application 07/709,121, filed May 31, 1991, now Patent No. 5,186,940, issued February 16, 1993, and Application No. 06/914,591, filed October 7, 1986, now Patent No. 5,041,581, issued August 20, 1991, and Application 06/788,750, filed October 18, 1985.

[2]Patent No. 5,041,581, based on Application 06/914,591, filed October 7, 1986, issued August 20, 1991. Accorded the benefit of Application 06/788,750, filed October 18, 1985.

[3]Patent No. 5,117,022, based on Application 07/234,892, filed August 22, 1988, issued May 26, 1992. Accorded the benefit of Application 06/788,750, filed October 18, 1985 and

Interference No. 103,352

v.

MITSUAKI MAEDA and TAKUMA SASAKI
Senior Party [4]

Patent Interference No. 103,352

FINAL HEARING: June 22, 2000

Before CAROFF, ELLIS, and LORIN, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

FINAL DECISION UNDER 37 CFR. 1.658(a)

This interference involves three patents which, according to the record before us, are each assigned to Board of Regents, The University of Texas System and, in addition, the interference involves an application of Maeda et al. (Maeda).[5]

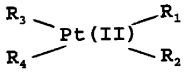
06/914,591, filed October 07, 1986, now Patent No. 5,041,581, issued August 20, 1991.

[4]Application 06/836,524, filed March 5, 1986. Accorded the benefit of Japan Application No. 60-43869/1985, filed March 6, 1985.

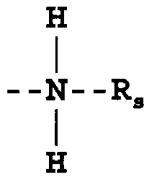
[5]In addition to having a common assignee, the three involved patents also have at least two named inventors in common, Abdul Khokhar and Roman Perez-Soler. Accordingly, for purposes of this decision, we shall collectively refer to the involved patents, their common assignee, and the named inventors associated with those patents as the party

According to the record before us, the Maeda application is assigned to Sumitomo Pharmaceuticals Co., Ltd.

The subject matter in issue relates to a platinum (II) four-coordinate complex which may be used as an anti-tumor chemotherapy agent. The complex is more specifically defined by the sole count of this interference as follows:



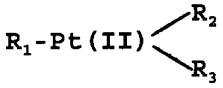
A platinum (II) four-coordinate complex having the formula:



wherein R_1 and R_2 are each alkyl carboxylato radicals bearing a hydro-phobic function or, when linked together, are a dicarboxylato radical bearing a hydrophobic function, and wherein R_3 and R_4 are each amines of the formula:

"Khokhar." See 37 CFR 1.601(l).

wherein R_s is selected from the group consisting of hydrogen, alkyl, aryl, aralkyl, alkenyl, cycloalkyl, or cycloalkenyl having between 1 and 20 carbon atoms; or wherein R_3 and R_4, when linked together, are selected from the group consisting of cycloalkyl-1,2-diamino having between about 3 and 7 carbon atoms, and alkyl-vicinal-diamino having between about 3 and 7 carbon atoms, and alkyl-vicinal-diamino having between about 2 and 12 carbon atoms; and said complex is defined further as being substantially soluble in methanol or chloroform and substantially insoluble in water;



or

a platinum (II) four-coordinate complex having the formula:

wherein R_1 is an alkyl diamine or cycloalkyl diamine and R_2 and R_3 are each a hydrophobic alkylcarboxylato containing from 5 to 14 carbon atoms.

The claims of the parties which correspond to this count are:

Perez-Soler et al.: (Patent No. 5,384,127)	Claims 1-3
Khokhar et al.: (Patent No. 5,117,022)	Claims 1-28
Khokhar et al.: (Patent No. 5,041,581)	Claims 1-40

Maeda et al.: Claims 1-6 and 11-13

Issues

The following matters were raised in the parties' briefs and, therefore, define the only issues before us for consideration:

I. The Khokhar motion to reopen the testimony period (Paper No. 35) relating to the proposed testimony of Sheryl L. Doran. (KB 16-19, 32).[6]

II. The Khokhar motion to disqualify counsel for Maeda (Paper No. 36) relating to an alleged conflict of interest. (KB 20-24).

III. A purported resolution of a conflict in the "PCT/EPO." (KB 24-26, 37-38).

IV. The prosecution history of the involved Maeda application. (KB 26-29,38).

V. The Maeda motion to suppress evidence. (Paper No. 57).

VI. The Khokhar request to return the Maeda reply associated with Maeda's motion to suppress. (Paper No. 62).

[6]KB refers to Khokhar's main brief.

VII. Whether evidence adduced by Khokhar is sufficient to establish a conception and actual reduction to practice of the invention defined by the count prior to Maeda's effective filing date of March 6, 1985.[7]

The party Khokhar has presented a record in the form of declaration testimony, and also submitted documentary exhibits. Senior party Maeda elected not to cross-examine any of Khokhar's declarants, and has chosen not to present any testimony or exhibits of its own. Both parties filed briefs and appeared, through counsel, at final hearing.[8]

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[7]Although Maeda's brief (page 1) makes passing reference to a question of Khokhar's diligence with respect to a reduction to practice, that particular question does not arise here since it was not argued in Khokhar's brief and no evidence has been proffered by Khokhar on that point. Therefore, in order to establish prior inventorship, Khokhar must prove to have been the first to reduce the invention at issue to practice regardless of any earlier date of conception. Accordingly, any proof of an earlier conception date is not material to Khokhar's case for priority; conception being subsumed within any proven actual reduction to practice. Cf. Smith v. Bousquet, 111 F.2d 157, 164, 45 USPQ 347, 354 (CCPA 1940).

[8]The record, exhibits, brief and reply brief of Khokhar hereinafter will be respectively referred to by the abbreviations "KR", "KX", "KB" AND "KRB" followed by an appropriate page or exhibit number. Similarly, Maeda's brief will be referred to as "MB".

No issue of interference-in-fact has been raised in this proceeding.

We shall now address each of the aforementioned issues seriatim.

I.

The Khokhar motion to reopen the testimony period was filed on Sept. 20, 1995, the same day Khokhar filed its brief. The motion was denied in an interlocutory order (Paper No. 48) issued by an Administrative Patent Judge (APJ) on Dec. 19, 1995. Khokhar did not request reconsideration of that order in accordance with 37 CFR 1.640(c), or otherwise challenge the order pursuant to 37 CFR 1.655(a) in its reply brief filed on Jan. 29, 1996. Accordingly, the motion to reopen the testimony period stands denied and, therefore, we shall not consider the proposed testimony of Sheryl Doran.

We note for the record that counsel for Khokhar orally requested at final hearing that we reconsider the denial of that motion. Any request for reconsideration at this time, over four years after the original order was issued, is considered, extremely belated. Moreover, a party is not ordinarily permitted to raise orally at final hearing a matter which could have been addressed in the party's brief or reply

brief. Cf. Rosenblum v. Hiroshima, 220 USPQ 383, 384 (Comm'r 1983). In this regard, any action on our part must be based exclusively on written correspondence, and not on oral communications. See 37 CFR 1.2. For all of the foregoing reasons, we cannot honor Khokhar's oral request.

II.

Similarly, the Khokhar motion to disqualify senior party counsel was filed on Sept. 20, 1995, and was dismissed in the same interlocutory order discussed above. Since Khokhar has not challenged the propriety of that order in any way, the motion to disqualify counsel stands dismissed.

III., IV.

Khokhar has failed to explain how the purported resolution of a conflict in prosecuting applications under the PCT or before the EPO is in any way relevant to any issue properly raised in this interference. Similarly, Khokhar has failed to explain how the prosecution history of Maeda's involved application relates in any way to an issue properly before us. Although Khokhar does not say as much, it may be surmised that these matters relate to questions which could have been pursued by way of preliminary motion under 37 CFR 1.633, e.g. questions of interference-in fact, of claim

correspondence, or questions relating to the scope of the count. However, Khokhar did not pursue any preliminary motions. Preliminary motions which Khokhar did file were withdrawn from consideration by Khokhar and, therefore, summarily dismissed (See Paper No. 17, page 1, footnote 1). Questions which could have been pursued via the preliminary motion route, but were not, are not entitled to be raised for consideration at final hearing. See 37 CFR 1.655(b) and Heymes w. Takaya, 6 USPQ 2d 1448, 1452 (BPAI 1988).

V.

The Maeda motion to suppress evidence is hereby dismissed as belated since it was not filed "with" Maeda's opening brief as required by 37 CFR 1.656(h). In fact, the motion was filed more than three weeks after Maeda had filed its brief. Maeda was incorrect in assuming that a motion to suppress can be considered timely if the substance of the motion was included within the brief rather than in a separate paper filed with the brief. On the contrary, as we interpret the rule, its clear intention is to require the filing of a separate motion paper along with the brief.

Additionally, dismissal of the motion is based on the fact that Maeda did not raise a timely objection to the admissibility of evidence introduced by Khokhar.

A party that failed to challenge the admissibility of evidence by timely objection may not later do so at final hearing via a motion to suppress. 37 CFR 1.656(h). In the absence of an order setting a specific date for filing objections, a timely objection to the admission of evidence should have been made as soon as possible after the evidence was offered. See Myers v. Feigelman, 455 F.2d 596, 602 n.12, 172 USPQ 580, 585 n.12, (CCPA 1972); Rivise and Caesar, Interference Law and Practice, Vol III, § 452, 453 (Michie Co. 1947).

Even assuming, arguendo, that Maeda had raised a timely objection and filed its motion to suppress with its opening brief, we find the arguments presented in the motion to be unpersuasive on the merits at least with respect to the admissibility of exhibits KX 3-5. In this regard, we take note of the admission by Maeda (MB-2) that those exhibits "are documents authored by Doran." In our view, this admission serves to authenticate the subject documents at least in so far as authorship, and thereby provides a basis for their

admissibility. Cf. White v. Habenstein, 219 USPQ 1213, 1215-16 (Bd. Pat. Int. 1983). Of course, the weight to be accorded these documents is quite another matter as discussed infra. See White v. Habenstein, 219 USPQ, at 1217-18.

VI.

Khokhar's request to return the Maeda reply associated with Maeda's motion to suppress will be treated as a miscellaneous motion and, as such, is summarily dismissed for failure to comply with 37 CFR 1.637(b). In any case, the request is moot in view of the dismissal of Maeda's motion to suppress.

VII.

After a thorough evaluation of all the evidence of record in this proceeding in light of the opposing positions taken by the parties in their briefs, we conclude that Khokhar has failed to establish an actual reduction to practice of the invention defined by the count prior to March 6, 1985 for lack of adequate corroboration.

Khokhar, as the junior party, has the burden of proving prior inventorship by a preponderance of the evidence. Peeler v. Miller, 535 F.2d 647, 651-52, 190 USPQ 117, 120-21 (CCPA 1976). Khokhar alleges conception and actual reduction to

practice of the invention at issue prior to Maeda's effective filing date. In attempting to prove this allegation, Khokhar relies almost exclusively upon the testimony of co-inventors Khokhar, Perez-Soler and Lopez-Berestein together with documentary exhibits.[9]

Even though the senior party did not cross-examine any of Khokhar's declarants and did not present any evidence of its own, Khokhar must nevertheless provide adequate corroboration of the inventors' testimony to establish a prima facie case for priority. The need for corroboration of an inventor's testimony to establish a prima facie case for priority is a fundamental and well-established principle of interference practice. Rivise and Caesar, Interference Law and Practice, Vol III, § 539 (Michie Co. 1947). Indeed, an inventor's testimony must be corroborated with regard to all the essential elements of a case for priority.

[9]The only testimony before us of a non-inventor is that of Patricia Oeckinghaus, and that testimony is limited solely to the authentication of a single exhibit (KX-6), which is purported to be an analytical report prepared by an outside laboratory, Robertson Laboratory, Inc. According to one of the inventors (KR-16), that report relates to an elemental analysis conducted at the outside laboratory.

The purpose of the rule requiring corroboration is to reduce the potential for fraud and to establish, by proof that is unlikely to have been fabricated or falsified, that the inventor successfully reduced his invention to practice. Berry v. Webb, 412 F.2d 261, 162 USPQ 170 (CCPA 1969). The evidence necessary for corroboration is determined by the rule of reason which involves an examination, analysis and evaluation of the record as a whole so that a reasoned determination as to the credibility of the inventor's story may be reached. Berges v. Gottstein, 618 F.2d 771, 205, USPQ 691 (CCPA 1980); Mann v. Werner, 347 F.2d 636, 146 USPQ 199 (CCPA 1965). Although adoption of the "rule of reason" has eased the requirement of corroboration with respect to the quantum of evidence necessary to establish the inventor's credibility, it has not altered the requirement that corroborative evidence must not depend solely on the inventor himself and must be independent of information received from the inventor. Reese v. Hurst, 661 F.2d 1222, 211 USPQ 936 (CCPA 1981); Mikus v. Wachtel, 542 F.2d 1157, 191 USPQ 571 (CCPA 1976).

Khokhar primarily relies upon its documentary exhibits, particularly KX 3-6 and KX-8, for corroboration of a reduction

to practice. With regard to a purported synthesis of at least one compound within the scope of the count, KX 3-5, documents admittedly authored by Sheryl Doran, can be given little weight as corroborative evidence. While there is no question as to authorship, there is no testimony of record other than that of the inventors themselves to explain the circumstances surrounding the entries made in those documents as to the dates and substance of the information recorded therein. Cf. White v. Habenstein, supra, at 1218. Documentary exhibits are generally not self-explanatory and must be discussed with particularity by a witness. 37 CFR 1.671(f); Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Int. 1975). Since only the inventors testified as to exhibits KX 3-5, we find that those exhibits do not constitute sufficient circumstantial evidence of an independent nature to satisfy the corroboration rule.

With regard to the analytical report from Robertson Laboratory (KX-6), it too has not been discussed with particularity by a witness other than inventor Khokhar (KR-16). Although non-inventor Oeckinghaus did testify for the purpose of authentication, she did not discuss any of the circumstances surrounding the entries made in the report.

Thus, the analytical report also does not constitute sufficient circumstantial evidence of an independent nature to corroborate synthesis of a compound within the scope of the count. Moreover, an elemental analysis alone is generally not definitive with regard to identification of a specific compound. Cf. Berges v. Gottstein, 618 F.2d at 774, 205 USPQ at 694.

Significantly, there is no evidence of record to corroborate the testing of compounds within the scope of the count to establish utility. Reduction to practice of a compound is generally not considered complete until it has been successfully tested to establish its utility. See Fujikawa v. Wattanasin, 39 USPQ 2d 1895, 1899 (Fed. Cir. 1996); De Solms v. Schoenwald, 15 USPQ 2d 1507, 1509 (BPAI 1990); Blicke v. Treves, 112 USPQ 472, 475 (CCPA 1957). With regard to such testing, Perez-Soler testified as to results of tests reported in his lab notebook (KX-8). Specifically, page 24 of the notebook refers to "Experiment 85-5," which is said to have been performed by Perez-Soler and to show anticancer activity exhibited by compounds within the scope of the count. There is no testimony of record, other than that of the inventors themselves, to corroborate these results.

The total lack of corroboration of the testing purportedly conducted by co-inventor Perez-Soler is dispositive of the issue of priority even if we assume, arguendo, that other evidence relied upon by Khokhar were sufficient to corroborate synthesis of at least one compound within the scope of the count prior to March 6, 1985.

For all of the foregoing reasons, we find that Khokhar has failed to establish a prior actual reduction to practice of the invention at issue due to a lack of adequate corroboration.

JUDGMENT

For the foregoing reasons, judgment as to the subject matter of the sole count in issue is hereby awarded to Maeda et al., the senior party.

Accordingly, Maeda et al. are entitled to a patent containing their claims 1-6 and 11-13 corresponding to the count. The junior party Khokhar is not entitled to any of the

following claims in its involved patents which correspond to the count: 1-3 (Patent No. 5,384,127), 1-28 (Patent No. 5,117,022), and 1-40 (Patent No. 5,041,581).

MARC L. CAROFF Administrative Patent Judge	)
JOAN ELLIS Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
HUBERT C. LORIN Administrative Patent Judge	)

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INTERFERENCE FILES:
103,352

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DECISION:

Prepared: December 5, 2001

Draft Final